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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/039,341	THOMAS, C. DOUGLASS
	Examiner	Art Unit
	Sam Rimell	2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>Decision of August 3, 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-27 and 31-33</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-27 and 31-33</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 13: Claim 13 has been amended to recite that the searching identifies an "identical" name, as well as a "variant" of the name being monitored. These features are not disclosed in the original disclosure, and are therefore new matter. As understood from applicant's original disclosure, the system only identifies whether the domain name is actually registered or not registered (steps 910-912 in applicant's FIG. 9). There are no steps of "identifying identical names" or "identifying variants of the name". Accordingly, these recited features are new matter.

Claim 14-27: Depend on claim 13.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Schneider (U.S. Patent 6,338,082) in view of Balijepalli et al. (U.S. Pre-Grant publication

2004/0230566).

Claim 1: Reference is made to FIG. 3A and its associated discussion at col. 12, line 57

through col. 13, line 25. Step 306 in FIG. 3A is the receipt of request to monitor a name by

initiating a search in a "WHOIS" database. Initiating a search is an act of monitoring.

Step (314) diagrammatically illustrates the search for the domain name in the WHOIS

database and the determination as to the existence of the name (also see col. 12, lines 62-67).

Step (318) illustrates the return to the requestor of a displayed record of a domain name

when such domain name is identified in the WHOIS database system.

Schneider differs in that the search step is not recited as being performed periodically and

automatically. However, Balijepalli et al. teaches the concept of periodically and automatically

performing a search for data on a network (paragraph 0008, last two lines) in order to return the

most relevant and recent information to the user (paragraph 0004, last three lines). The periodic

searching produces periodic results (paragraph 0005, first four lines). It would have been obvious

to one of ordinary skill in the art to modify Schneider to perform periodic automatic searches and

automatically deliver the results to the user in order to provide the most relevant and current

information, as taught by Balijepalli et al.

Claim 2: URLs associated with domain names can be communicated via electronic mail

(col. 5, line 38).

Claim 3: The monitored name is a domain name (FIG. 3A, step 306).

Claim 4: A "WHOIS" database is a registry of domain names, and a plurality of such registries exist throughout the world (col. 5, lines 15-24).

Claim 5: Col. 5, lines 40-44 illustrate a domain name as a string of characters ("example.com").

Claim 6: FIG. 3A, step 306 establishes that a search is performed for a domain name. Col. 5, lines 40-44 establish that a domain name is a string of characters ("example. com"). Accordingly, the search for the domain name involves a search for a string of characters.

Claim 7: The search of the WHOIS database registries involves searching all entries for matches. Such a search would inherently involve relatively more recent entries and relatively older entries.

Claim 8: FIG. 3A illustrates the generation of a notification message (display record). The display record is displayed to the user who initiated the request, thus the message is forwarded to the requestor.

Claim 9: The WHOIS database inherently contains data on domain name registrant, contact information, and date of registration or update to registration. Examiner has provided a copy of a WHOIS search for "Washington College" as evidence to support this conclusion, although the search results are not being referred to as prior art, since examiner maintains that the claimed features are inherent, rather than obvious.

Claim 10: FIG. 3A, step (306) illustrates receiving a request from a requestor. The request can be made over the Internet using a TCP/IP application (col. 5, lines 5-15).

Claim 32: Col. 6, lines 60-64 provide an example of where a template search term is used where the template search term includes both text and the wildcard character "%".Schneider

differs in that the search step is not recited as being performed periodically and automatically. However, Balijepalli et al. teaches the concept of periodically and automatically performing a search for data on a network (paragraph 0008, last two lines) in order to return the most relevant and recent information to the user (paragraph 0004, last three lines). The periodic searching produces periodic results (paragraph 0005, first four lines). It would have been obvious to one of ordinary skill in the art to modify Schneider to perform periodic automatic searches and automatically deliver the results to the user in order to provide the most relevant and current information, as taught by Balijepalli et al.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11-12, 31 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Schneider (U.S. Patent 6,338,082).

Claim 11: Reference is made to FIG. 3A and its associated discussion at col. 12, line 57 through col. 13, line 25. Step 306 in FIG. 3A is the receipt of request to monitor a name by initiating a search in a "WHOIS" database. Initiating a search is an act of monitoring.

Step (314) diagrammatically illustrates the search for the domain name in the WHOIS database and the determination as to the existence of the name (also see col. 12, lines 62-67).

Step (318) illustrates the return to the requestor of a displayed record of a domain name when such domain name is identified in the WHOIS database system.

The displayed search results from the WHOIS database search (step 318) would constitute a warning message indicating that a domain name is in use by another party.

Claim 12: The display of search results from the WHOIS search (step 318) is automated (done without manually searching through all the record). Accordingly, the action of sending a message (displayed results) is done automatically.

Claim 31: The input of the requested name is provided through the Internet (FIG. 1A).

Claim 33: Reference is made to FIG. 3A and its associated discussion at col. 12, line 57 through col. 13, line 25. Step 306 in FIG. 3A is the receipt of request to monitor a name by initiating a search in a "WHOIS" database. Initiating a search is an act of monitoring.

Step (314) diagrammatically illustrates the search for the domain name in the WHOIS database and the determination as to the existence of the name (also see col. 12, lines 62-67).

Step (318) illustrates the return to the requestor of a displayed record of a domain name when such domain name is identified in the WHOIS database system.

Remarks

This office action includes new grounds of rejection and is accordingly made non-final.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.

Sam Rimell
Primary Examiner
Art Unit 2164